

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hong-Yi Wu, et al.

Serial No.: 10/696,300

Examiner: A. Bashore

Filed: 10/29/2003

Group Art Unit: 1762

For: METHOD AND SYSTEM OF CONTROLLING DUMMY DISPENSE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Restriction Requirement dated June 19, 2006. The Examiner requires an election between Group I, **Claims 1-16** drawn to a method; or Group II, **Claims 17-28**, drawn to an apparatus.

Applicants hereby provisionally elect to prosecute Group I, claims 1-16. This election is made with traverse.

In addition, the Examination of both groups concurrently is requested, given the commonality of subject matter between the groups. The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 – Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) – Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)).

Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully submit that the claims of Groups I and II are closely related such that examination of both groups would not pose an undue burden on the Examiner. The Examiner would have to review substantially the same prior art to examine Groups II as is already being searched and reviewed in order to examine the elected Group I. Accordingly, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,

Dated: 7/18/06

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